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| 10/030,078 | 06/21/2002 | Norbert Albrecht | ALBR3001/JEK | 5670 |

23364 7590 03/22/2007
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| EXAMINER |
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HEWITT II, CALVIN L

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| ART UNIT | PAPER NUMBER |
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3621

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/22/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/030,078

Applicant(s)

ALBRECHT ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-25 have been examined.

Response to Amendments/Arguments

2. Applicant is of the opinion that the Examiner's rejection to claims 1 and 9 in light of *In re Collier* was improper because the claim precisely defines the structural attributes of the claimed apparatus. The Examiner respectfully disagrees. The claims at issue in *In re Venezia* are directed to a "kit". A "kit" by its nature is something to be assembled, therefore, it is appropriate to discuss how it is to perform in the future (i.e. post assembly). Applicant's claims, on the other hand, are directed to an existing structure, and to one of ordinary skill, Applicant has not clearly defined, for example in claims 1 and 21, whether or not the claimed terminal *is* ("being suitable") or *is not* suitable ("the terminal is determined to be not suitable") to perform a transaction. Claims 1 and 9 recite a terminal making a suitability determination based on transaction data from a portable data carrier. However, Applicant has not precisely defined a connection between the terminal and a portable data carrier ("when accessed") hence it is not clear to one of ordinary skill how the transaction data is conveyed to the terminal (see *In re Venezia*, However, we found that the claim did not positively

recite any structural relationship between the two elements identified as [1] and [2], in its recitation of what may or may not occur. We concluded that the claim failed to comply with section 112, second paragraph, in "failing distinctly to claim what appellant in his brief insists is his actual invention.").

Regarding claims 4 and 10, according to claim 1, functionality data is transmitted based on a determination that a terminal is not suitable to perform a transaction. Claim 4 is directed to transmitting functionality data following the occurrence of a predetermined event. In order for claim 4 to depend from claim 1 the predetermined event must coincide with a suitability determination otherwise claim 4 describes a system where functionality can be transmitted without suitability being determined. However, this results in a contradiction as claim 1, at least based on the last two limitations, transmits functionality data only after the terminal is determined to be not suitable.

Claim 6 has been amended to recite "at least one central processing unit *configured to be conditionally included* in a transaction" (emphasis added). According to *In re Venezia*, it is appropriate to reject a claim under 112 second paragraph when a claim does not positively recite a structural relationship between two elements of the structure (However, we found that the claim did not positively recite any structural relationship between the two elements identified as [1] and [2], in its recitation of what may or may not occur. We concluded that the claim failed to comply with section 112, second paragraph, in "failing distinctly

to claim what appellant in his brief insists is his actual invention.”). Therefore, as the relationship between the CPU and the node computer is not positively recited (“conditionally included”) a rejection under 112 second paragraph is appropriate.

Regarding the appliance of Southgate, Southgate is directed to both upgrades and fixes (column 2, lines 33-37), therefore Applicant’s analysis is inaccurate and the claims remain rejected in view of the combined prior art.

The following assertion of fact has gone unchallenged and are therefore considered admitted prior art:

- device for affecting cryptographic communications is a box (e.g. encryption/decryption box, chip)

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 1 and 9 are directed to structure but recite limitations in terms of possibility. It has been held that actions that may or may not be done is indefinite and does not distinguish the claim from the prior art (*In re Collier*, 158 USPQ 266

(CCPA 1968); *In re Venezia*, 189 USPQ 149 (C.C.P.A. 1976)) therefore claims 1, 3-7 and 9 are rejected under 112 second paragraph.

Claims 2-8, 10-13, 15-18, 22 and 23 are also rejected as each depends from claim 1, 3-7 or 9.

b) Claims 4 and 10 recite cause transmission of functionality data based on the occurrence of a predetermined event. However, in each instance transmission is triggered by a determination that a terminal is not suitable to perform a transaction, hence transmission cannot be based on a predetermined event unless the terminal's lack of suitability was predetermined.

c) Claim 6 recites "at least one central processing unit and the latter is includable in a transaction" (wherein "latter" is interpreted as the central processing unit). However, to one of ordinary skill a transaction comprises data such as price, item to be purchased, credit card number, buyer ID and seller ID, therefore it is not clear to one of ordinary skill how a central processing unit would comprise data in a transaction (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

d) Claim 21 is directed a terminal suitable for performing a transaction. However, the claim also recites transmitting a start sequence designating at least one transaction the terminal is *not suitable* for performing". Therefore, Applicant's the properties of the claimed terminal is unclear to one of ordinary skill (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

Claim 25 is also rejected as it depends from claim 21.

e) The claims [1-21] are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daly et al., U.S. Patent No. 5,878,141 in view of Southgate, U.S. Patent No. 6,205,579.

As per claims 1-7, 9-11, 13 and 15-25, Daly et al. teach:

- a node computer is connected with a plurality of terminals (figure 1) wherein the computer stores data and can call data from a central processing unit

- terminals for accessing a portable data carrier to complete a transaction (i.e. elements of the terminal's processor unit are formed partly on the portable data carrier) (column/line 8/62-9/8)
- completing a transaction between the terminal and the node computer (figure 1; column 6; lines 37-67)
- a transaction is performed with the node and the terminal each performing partial steps of the transaction (abstract; figures 2 and 5-7)
- a terminal comprising a processor, storage, network interface with node computer, means for triggering a transaction (e.g. keyboard and display) and apparatus for reading a portable data carrier (figures 1 and 5; column 6, lines 37-67; column 7, lines 33-40)

Daly et al. do not specifically recite a terminal making a determination whether it is capable to perform a transaction and if not retrieving from a host computer data for enabling the performance of said transaction. Southgate discloses a software update system wherein a terminal makes a determination that the terminal is not suitable to perform a request and as a result contacts a node computer in order to obtain data (i.e. cause transfer or transmission of data following the occurrence of a condition) to enable the terminal to fulfill the request wherein the terminal stores the data for future use (abstract; column 3, lines 29-44; column 4, lines 28-47 and 60-67; column 6, lines 27-67; column 7, lines 1-8

and 22-35; column/line 8/32-9/15). Southgate also teaches a terminal transmitting a start sequence to the node computer that comprises the type of terminal and the type of error (e.g. temporary results or necessary files for troubleshooting the error) for requesting data that enables the terminal to fulfill the request (column/line 5/60-6/13; column 9, lines 19-39) Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Daly et al. and Southgate in order to correct errors ('579, column/line 8/32-9/15) in the client system ('141, figure 1; column 7, lines 25-40) that prevent a user from completing a transaction ('141, column 7, lines 25-40; column/line 8/62-9/8).

As per claims 8 and 12, Daly et al. teach securing terminal and node communications using public key cryptography with key exchange (column/line 14/10-16/33). A well-known device for affecting cryptographic communications is a box (e.g. encryption/decryption box, chip).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

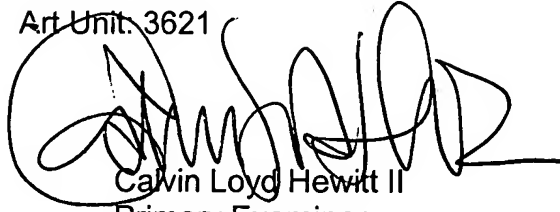
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Calvin Lloyd Hewitt II", is written over the text "Art Unit: 3621". The signature is stylized with large, sweeping loops.

Calvin Lloyd Hewitt II
Primary Examiner

March 18, 2007